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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,143	10/14/2003	Jay S. Walker	02-040	4772
22927 7590 03/19/2008 WALKER DIGITAL MANAGEMENT, LLC 2 HIGH RIDGE PARK STAMFORD, CT 06905				
EXAMINER				
LEIVA, FRANK M				
ART UNIT		PAPER NUMBER		
3714				
MAIL DATE		DELIVERY MODE		
03/19/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/685,143

Applicant(s)

WALKER ET AL.

Examiner

Frank M. Leiva

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-893)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. In view of the appeal brief filed on 05 November 2007, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3714

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was

made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 21-26 and 55 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over LeMay et al. (U.S. 6,942,574).

4. Regarding claims 1 and 21; LeMay discloses: A method, comprising;

Determining a message; identifying a game machine; determining gaming activity associated with a player, (col. 1:7-11, col. 3:4-7 and col. 3:21-23), allowing access to the entertainment content sources based upon the player tracking information.

Determining a feature of the game machine, the feature being selected based on the gaming activity, (col. 3:20-23), the feature selectable based on the player tracking information.

Wherein the feature comprises a feature that may be activated based on a selection by the player; (col. 3:7-10), whereas the system receives input of the selection from the player.

Outputting the message to a player via the game machine, the message comprising a recommendation of the feature, (col. 3:14-19), wherein the system outputs a message advising of the various cost of the feature. Thus, either LeMay inherently includes a recommendation or it would have been obvious to one of ordinary skill in the art at the time of the applicants invention to interpret an advise of cost as recommendations regarding the feature, one is to include that recommendations may vary according to the nature of the selected video feature, as for example the video presentation may have several different price ranges depending of the media or specific Network channel selected.

5. Regarding claims 2 and 22; LeMay discloses: wherein determining the message includes determining a status message, (col. 5:41-47).

6. **Regarding claims 3 and 23;** LeMay discloses: wherein determining the message includes determining an instructive message, (3:14-19).

7. **Regarding claims 4 and 24;** LeMay discloses: wherein determining the message includes determining a communication message, (col. 5:41-47).

8. **Regarding claims 5 and 25;** LeMay discloses: wherein determining the message includes determining a promotional message, (col. 2:15-29).

9. **Regarding claims 6 and 26;** LeMay discloses: wherein determining the message includes determining an activity-benefit offer, (col. 3:55-60).

10. **Regarding claim 55;** LeMay discloses a method, comprising:

Determining an occurrence of a trigger condition; identifying a message in a database of messages based on the trigger condition; identifying a game machine from among a plurality of game machines based on the message; suppressing output of the message until a second trigger condition is satisfied; and displaying the identified message in a partition on the identified game machine upon satisfaction of the second trigger condition, (col. 3:4-23), whereas the system provides game outcome presentations for one or more games, (i.e. is triggered to send updates of games that the player has selected to track) it has to track the movement of the player on the floor to deliver the messages, and the player has to pay or have enough play history to be able to receive the content (i.e. second trigger is payment).

Wherein the partition is a pop-up window, and (figure 2(item 275 and 257)).

Wherein the identified message includes a feature recommendation, (col. 3:14-19), wherein the system outputs a message advising of the various cost of the feature. Thus, either LeMay inherently includes a recommendation or it would have been obvious to one of ordinary skill in the art at the time of the applicants invention to interpret an advise of cost as recommendations regarding the feature, one is to include that recommendations

may vary according to the nature of the selected video feature, as for example the video presentation may have several different price ranges depending of the media or specific Network channel selected.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 36-40 and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by LeMay.

13. **Regarding claims 36 and 38;** LeMay discloses: A method, comprising:

Determining a message; determining a first representation of the message and a second representation of the message; outputting the first representation of the message to a first player at a game machine; and outputting the second representation of the message to a second player at a game machine, (col. 4:61-67), similar content as presented in TV format is available in WEB page format so that two players can view the same content in two different formats.

wherein determining the first representation includes selecting a representation based upon a characteristic of the first player, and wherein determining the second representation includes selecting a representation based upon a characteristic of the second player, (col. 4:66-67), upon the player tracking information, player preferences are

kept and for those more sophisticated players, the content will be sent in their preferred format.

Wherein determining the first representation includes selecting a representation based upon an indication by the first player, and wherein determining the second representation includes selecting a representation based upon an indication by the second player, (col. 3:7-10), whereas the system receives input of the selection from the player.

14. Regarding claims 37 and 39; LeMay discloses wherein the first representation is different from the second representation, (col. 4:64-67). Whereas different media are considered different representations.

15. Regarding claim 40; LeMay discloses a method, comprising; determining a message to be output to a player at a game machine; and suppressing output of the message, and wherein suppressing output of the message includes delaying output of the message until a trigger condition is satisfied, (col. 3:14-23), prior to outputting the message, the system holds the information till it confirms that the credits indicia is paid (trigger event), thus the message is already created and waiting for the player to satisfy a condition before sending.

16. Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over LeMay as applied to claim 1 above, and further in view of Fuchs (US 6,126,541).

17. Regarding (US 6,126,541); Fuchs discloses a gaming machine that provides either automatically or by calling of the player a display of the best options the player can take and the probabilities of the possible winning scenarios if the player chooses one of the choices.

18. **Regarding claim 56;** LeMay discloses the method of claim 1 but does not disclose how the result of the selection would have been different otherwise selected. Fuchs discloses wherein the message further comprises data indicating how a result of the gaming activity would have been different if the recommended feature had been activated during the gaming activity, (col. 6:16-39). It would be obvious to one of ordinary skill in the art at the time of the invention to incorporate the disclosure of Fuchs with the game of Lemay includes all of the player tracking features and messaging systems. This combination would yield the predictable result as to include hints and training during the game for the player's enjoyment. Fuchs already discloses the advantages of this instructing feature for the player and would make it a great message, "prize information, or advertisements of interest to the player playing the game on the gaming machine".

Response to Arguments

19. Applicant's arguments filed 05 November 2007 have been fully considered but they are not persuasive for the following reasons.

20. Regarding the argument directed to LeMay's teachings of **claim 1** (page 16) and **claim 21** (page 19), "Appellants respectfully assert that claim 1 recites the following limitation that is not taught or suggested by LeMay:

- outputting a message to a player via the game machine, the message comprising a recommendation of the feature [of the game machine]", the examiner points to Lemay (col. 3:14-19) "Additionally, the method may include, a) prior to outputting the entertainment content, determining an indicia of credit amount for the selected entertainment content source, b) displaying a message on the display device notifying a player of the required indicia of credit amount", the system acknowledges the players choice and advises (i.e. recommends) the feature requires additional payment.

21. Regarding the argument directed to LeMay's teachings of **claims 36 and 38** (page 22), "Appellants respectfully assert that claims 36 and 38 recite the following limitations that are not taught or suggested by LeMay:

- determining a first representation of the message and a second representation of the message;
- outputting the first representation of the message to a first player at a game machine;
- outputting the second representation of the message to a second player at a game machine;" the examiner points to LeMay (col. 4:61-67), "Also, the television programming entertainment content may be displayed while a player is engaged in playing a game on the gaming machine or between games. Similarly, the entertainment content may include information available on the Internet, including the World Wide Web, for more technologically sophisticated players", emphasis added to the point of the same information presented as TV programming is also available to players in Web page format for viewing.

22. Regarding the argument directed to LeMay's teachings of **claims 36 and 38** (page 24), "Appellants further assert that LeMay does not teach or otherwise suggest the following element of claim 36:

- wherein determining the first representation includes selecting a representation based upon a characteristic of the first player, and wherein determining the second representation includes selecting a representation based upon a characteristic of the second player", the examiner points to LeMay (col. 4:66-67), for more technologically sophisticated players (ie displayed according to players preference or characteristic), players preferences contained in the player tracking system.

23. Regarding the argument directed to LeMay's teachings of **claims 36 and 38** (page 25), "Appellants further assert that LeMay does not teach or otherwise suggest the following element of claim 38:

- wherein determining the first representation includes selecting a representation based upon an indication by the first player, and wherein determining the second representation includes selecting a representation based upon an indication by the second player", the examiner points to LeMay (col. 3:7-10), The method may be characterized as including: 1) displaying a list of one or more entertainment content sources, 2) receiving a selection of the entertainment content source from said list, whereas receiving a selection is an input from the player of the selected content and of course the format in which the player requested it.

24. Regarding the argument directed to LeMay's teachings of **claim 40** (pages 26-27) and **claim 55** (pages 28-29), *"Independent claim 40 recites the following limitation that is not taught or suggested by LeMay:*

- suppressing output of the message, wherein suppressing output of the message includes delaying output of the message until a trigger condition is satisfied", the examiner points to LeMay (col. 3:14-23), "Additionally, the method may include, a) prior to outputting the entertainment content, determining an indicia of credit amount for the selected entertainment content source, b) displaying a message on the display device notifying a player of the required indicia of credit amount and c) initiating the selected entertainment content when the required indicia of credit amount is available on the gaming machine or i) prior to receiving the selection, receiving player tracking information and ii) allowing access to the entertainment content sources based upon the player tracking information", prior to outputting the message, the system holds the information till it confirms that the credits indicia is paid (trigger event),

thus the message is already created and waiting for the player to satisfy a condition before sending.

25. Regarding the argument directed to LeMay's teachings of **claim 56**; have been considered but are moot in view of the new ground(s) of rejection.

26. Regarding arguments directed to dependent **claims 2-6 and 22-26**, please refer to rejections stated above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank M. Leiva whose telephone number is (571) 272-2460. The examiner can normally be reached on M-Th 9:30am - 5:pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FML

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3714